

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS**

ARDUINO, LLC,

Plaintiff,

-v-

ARDUINO S.R.L. f/k/a SMART PROJECTS
S.R.L.; GHEO SA; CC LOGISTICS, LLC;
MAGYC NOW LTD; DOG HUNTER INC.; DOG
HUNTER LLC; DOG HUNTER AG; TULYP
HOLDING SA; GIANLUCA MARTINO;
FEDERICO MUSTO; and DOES 1-10,

Defendants.

Civil Action No.: 1:15-cv-10181-DJC

**ANSWER AND AFFIRMATIVE DEFENSES TO
ARDUINO S.R.L.'S COUNTERCLAIMS**

Pursuant to Fed. R. Civ. P. 8, Plaintiff/Counterclaim-Defendant, Arduino, LLC (“Arduino”), by and through its undersigned counsel, as and for its Answer to Defendant/Counterclaim-Plaintiff Arduino S.R.L. f/k/a Smart Projects S.R.L.’s Counterclaims (“Smart Projects”), responds and states as follows:

PARTIES

1. Arduino admits the allegation of Paragraph 1 of the Counterclaims.
2. Arduino admits the allegation of Paragraph 2 of the Counterclaims.

JURISDICTION AND VENUE

3. Arduino admits the allegation of Paragraph 3 of the Counterclaims.
4. Arduino admits the allegation of Paragraph 4 of the Counterclaims.
5. Arduino admits the allegation of Paragraph 5 of the Counterclaims.

6. Arduino admits the allegation of Paragraph 6 of the Counterclaims.

7. Arduino admits the allegation of Paragraph 7 of the Counterclaims.

FACTUAL BACKGROUND

8. Arduino admits the allegation that Smart Projects manufactures computer hardware. Arduino lacks knowledge and information sufficient to form a belief as to the truth of the remaining allegations in Paragraph 8 of the Counterclaims, and therefore denies the same.

9. Arduino denies the allegations set forth in Paragraph 9 of the Counterclaims.

10. Arduino lacks knowledge and information sufficient to form a belief as to the truth of the allegations in Paragraph 10 of the Counterclaims, and therefore denies the same.

11. Arduino denies the allegations set forth in Paragraph 11 of the Counterclaims.

12. Arduino denies the allegations set forth in Paragraph 12 of the Counterclaims.

13. Arduino lacks knowledge and information sufficient to form a belief as to the truth of the allegations in Paragraph 13 of the Counterclaims, and therefore denies the same.

14. Arduino denies the allegations set forth in Paragraph 14 of the Counterclaims.

15. Arduino admits the allegations set forth in Paragraph 15 of the Counterclaims

16. Arduino denies the allegations set forth in Paragraph 16 of the Counterclaims.

17. Arduino denies the allegations set forth in Paragraph 17 of the Counterclaims.

18. Arduino admits the allegations set forth in the first sentence of Paragraph 18 of the Counterclaims. Arduino denies the allegations set forth in the second sentence of Paragraph 18 of the Counterclaims. Arduino denies the allegations set forth in the third sentence of Paragraph 18 of the Counterclaims.

19. Arduino denies the allegations set forth in Paragraph 19 of the Counterclaims.

20. Arduino admits that it is no longer working with Smart Projects as a manufacturing partner. Arduino denies the remaining allegations set forth in Paragraph 20 of the Counterclaims.

21. Arduino denies the allegations set forth in Paragraph 21 of the Counterclaims.

22. Arduino denies the allegation set forth in Paragraph 22 of the Counterclaims that “Arduino LLC is not the rightful owner of any ARDUINO trademarks.” Arduino admits the remaining allegations set forth in Paragraph 22 of the Counterclaims.

23. Arduino admits the allegations set forth in the first sentence of Paragraph 23 of the Counterclaims. Arduino denies the allegations set forth in the second sentence of Paragraph 23 to the extent that it states the incorrect registration date and registration number. Arduino admits that on the basis of U.S. Trademark Application No. 85/144,567, the USPTO, on March 20, 2012, issued U.S. Registration No. 4,113,794 to Arduino LLC. Registration No. 4,113,794 speaks for itself.

24. Arduino denies the allegations set forth in Paragraph 24 of the Counterclaims, except that Arduino admits that Smart Projects initiated a proceeding before the TTAB seeking cancellation of Arduino’s registrations.

25. Arduino admits the allegations set forth in Paragraph 25 of the Counterclaims.

26. Arduino admits that there is a pending lawsuit between the parties in Italy. Smart Projects mischaracterizes that lawsuit, and therefore, Arduino denies the remaining allegations set forth in Paragraph 26 of the Counterclaims.

27. Arduino admits that an Italian court denied a preliminary injunction with respect to a subset of marks at issue in this action, but not including the ARDUINO word mark. Arduino denies the remaining allegations set forth in Paragraph 27 of the Counterclaims.

28. Arduino admits that the denial of a preliminary injunction regarding a subset of marks at issue in this action was affirmed by an Italian court. Arduino denies the remaining allegations set forth in Paragraph 28 of the Counterclaims.

29. The documents from the Italian proceedings speak for themselves. Arduino denies the allegations set forth in Paragraph 29 of the Counterclaims.

30. The documents from the Italian proceedings speak for themselves. Arduino denies the characterization set forth by Smart Projects in Paragraph 30 of the Counterclaims. Arduino further lacks knowledge and information sufficient to form a belief as to the accuracy of the translation set forth in Paragraph 30 of the Counterclaims.

31. The documents from the Italian proceedings speak for themselves. Arduino denies the characterization set forth by Smart Projects in Paragraph 31 of the Counterclaims. Arduino further lacks knowledge and information sufficient to form a belief as to the accuracy of the translation set forth in Paragraph 31 of the Counterclaims.

32. The documents from the Italian proceedings speak for themselves. Arduino denies the characterization set forth by Smart Projects in Paragraph 32 of the Counterclaims. Arduino further lacks knowledge and information sufficient to form a belief as to the accuracy of the translation set forth in Paragraph 32 of the Counterclaims.

33. The documents from the Italian proceedings speak for themselves. Arduino denies the characterization set forth by Smart Projects in Paragraph 33 of the Counterclaims. Arduino further lacks knowledge and information sufficient to form a belief as to the accuracy of the translation set forth in Paragraph 33 of the Counterclaims.

34. The documents from the Italian proceedings speak for themselves. Arduino denies the characterization set forth by Smart Projects in Paragraph 34 of the Counterclaims.

Arduino further lacks knowledge and information sufficient to form a belief as to the accuracy of the translation set forth in Paragraph 34 of the Counterclaims.

35. Arduino denies the allegations set forth in Paragraph 35 of the Counterclaims.

36. Arduino denies the allegations set forth in Paragraph 36 of the Counterclaims.

37. Arduino denies the allegations set forth in Paragraph 37 of the Counterclaims.

38. Arduino denies the allegations set forth in Paragraph 38 of the Counterclaims.

39. Arduino denies the allegations set forth in Paragraph 39 of the Counterclaims.

COUNT I

Cancellation of Arduino LLC's U.S. Trademark Registrations.

Nos: 3,931,675 and No. 4,113,794

40. Arduino repeats each of its responses to Paragraphs 1-39 of the Counterclaims as if set forth herein.

41. Arduino admits the allegations set forth in Paragraph 41 of the Counterclaim.

42. Paragraph 42 of the Counterclaims sets forth a legal conclusion that is not an allegation of fact and does not require a response. To the extent a response is required, Arduino denies the allegations set forth in Paragraph 42 of the Counterclaims.

COUNT II

Cancellation of Arduino LLC's U.S. Trademark Registrations.

Nos: 3,931,675 and No. 4,113,794

43. Arduino repeats each of its responses to Paragraphs 1-42 of the Counterclaims as if set forth herein.

44. Paragraph 44 of the Counterclaims sets forth a legal conclusion that is not an allegation of fact and does not require a response. To the extent a response is required, Arduino denies the allegations set forth in Paragraph 44 of the Counterclaims.

COUNT III

Trademark Infringement and False Designation of Origin in Violation of § 43(a) of the Lanham Act (15 U.S.C. § 1125(a))

45. Arduino repeats each of its responses to Paragraphs 1-44 of the Counterclaims as if set forth herein.

46. Paragraph 46 of the Counterclaims sets forth a legal conclusion that is not an allegation of fact and does not require a response. To the extent a response is required, Arduino denies the allegations set forth in Paragraph 46 of the Counterclaims.

47. Paragraph 47 of the Counterclaims sets forth a legal conclusion that is not an allegation of fact and does not require a response. To the extent a response is required, Arduino denies the allegations set forth in Paragraph 47 of the Counterclaims.

48. Paragraph 48 of the Counterclaims sets forth a legal conclusion that is not an allegation of fact and does not require a response. To the extent a response is required, Arduino denies the allegations set forth in Paragraph 48 of the Counterclaims.

COUNT IV

Federal Unfair Competition and False Advertising under 15 U.S.C. § 1125(a)

49. Arduino repeats each of its responses to Paragraphs 1-48 of the Counterclaims as if set forth herein.

50. Paragraph 50 of the Counterclaims sets forth a legal conclusion that is not an allegation of fact and does not require a response. To the extent a response is required, Arduino denies the allegations set forth in Paragraph 50 of the Counterclaims.

51. Arduino denies the allegations set forth in Paragraph 51 of the Counterclaims.

52. Paragraph 52 of the Counterclaims sets forth a legal conclusion that is not an allegation of fact and does not require a response. To the extent a response is required, Arduino denies the allegations set forth in Paragraph 52 of the Counterclaims.

53. Paragraph 53 of the Counterclaims sets forth a legal conclusion that is not an allegation of fact and does not require a response. To the extent a response is required, Arduino denies the allegations set forth in Paragraph 53 of the Counterclaims.

54. Paragraph 54 of the Counterclaims sets forth a legal conclusion that is not an allegation of fact and does not require a response. To the extent a response is required, Arduino denies the allegations set forth in Paragraph 54 of the Counterclaims.

55. Paragraph 55 of the Counterclaims sets forth a legal conclusion that is not an allegation of fact and does not require a response. To the extent a response is required, Arduino denies the allegations set forth in Paragraph 55 of the Counterclaims.

COUNT V

Trademark Dilution Under M.G.L.A. c. 110H § 13

56. Arduino repeats each of its responses to Paragraphs 1-55 of the Counterclaims as if set forth herein.

57. Arduino denies the allegations set forth in Paragraph 57 of the Counterclaims.

58. Paragraph 58 of the Counterclaims sets forth a legal conclusion that is not an allegation of fact and does not require a response. To the extent a response is required, Arduino denies the allegations of Paragraph 58 of the Counterclaims to the extent they imply that Smart Projects is the owner of the ARDUINO mark.

59. Paragraph 59 of the Counterclaims sets forth a legal conclusion that is not an allegation of fact and does not require a response. To the extent a response is required, Arduino

denies the allegations of Paragraph 59 of the Counterclaims to the extent they imply that Smart Projects is the owner of the ARDUINO mark.

60. Paragraph 60 of the Counterclaims sets forth a legal conclusion that is not an allegation of fact and does not require a response. To the extent a response is required, Arduino denies the allegations set forth in Paragraph 60 of the Counterclaims.

61. Paragraph 61 of the Counterclaims sets forth a legal conclusion that is not an allegation of fact and does not require a response. To the extent a response is required, Arduino denies the allegations set forth in Paragraph 61 of the Counterclaims.

COUNT VI

Common Law Unfair Competition

62. Arduino repeats each of its responses to Paragraphs 1-61 of the Counterclaims as if set forth herein.

63. Paragraph 63 of the Counterclaims sets forth a legal conclusion that is not an allegation of fact and does not require a response. To the extent a response is required, Arduino denies the allegations set forth in Paragraph 63 of the Counterclaims.

64. Paragraph 64 of the Counterclaims sets forth a legal conclusion that is not an allegation of fact and does not require a response. To the extent a response is required, Arduino denies the allegations set forth in Paragraph 64 of the Counterclaims.

COUNT VI

Common Law Unfair Competition

65. Arduino repeats each of its responses to Paragraphs 1-64 of the Counterclaims as if set forth herein.

66. Paragraph 66 of the Counterclaims sets forth a legal conclusion that is not an allegation of fact and does not require a response. To the extent a response is required, Arduino denies the allegations set forth in Paragraph 66 of the Counterclaims.

67. Paragraph 67 of the Counterclaims sets forth a legal conclusion that is not an allegation of fact and does not require a response. To the extent a response is required, Arduino denies the allegations set forth in Paragraph 67 of the Counterclaims.

68. Paragraph 68 of the Counterclaims sets forth a legal conclusion that is not an allegation of fact and does not require a response. To the extent a response is required, Arduino denies the allegations set forth in Paragraph 68 of the Counterclaims.

69. Paragraph 69 of the Counterclaims sets forth a legal conclusion that is not an allegation of fact and does not require a response. To the extent a response is required, Arduino denies the allegations set forth in Paragraph 69 of the Counterclaims.

70. Paragraph 70 of the Counterclaims sets forth a legal conclusion that is not an allegation of fact and does not require a response. To the extent a response is required, Arduino denies the allegations set forth in Paragraph 70 of the Counterclaims.

ANSWER TO PRAYER FOR RELIEF

Plaintiff/Counterclaim-Defendant, Arduino, denies that Defendant/Counterclaim-Plaintiff, Smart Projects, is entitled to the judgment and relief prayed for in its Prayer for Relief.

GENERAL DENIAL

Arduino denies each and every factual allegation in the Complaint that is not specifically admitted or otherwise addressed in the preceding Paragraphs and demands strict proof thereof.

AFFIRMATIVE DEFENSES

As and for its Affirmative Defenses to Defendant/Counterclaim-Plaintiff's Counterclaims, Arduino hereby alleges as follows:

First Affirmative Defense

Arduino owns and has valid rights in the ARDUINO marks worldwide.

Second Affirmative Defense

Defendant/Counterclaim-Plaintiff is not entitled to the relief requested in the Counterclaims, in whole or in part, by virtue of the doctrines of estoppel, waiver, acquiescence, and/or laches.

Third Affirmative Defense

Defendant/Counterclaim-Plaintiff's Counterclaims fail to state a claim upon which relief can be granted.

Fourth Affirmative Defense

Defendant/Counterclaim-Plaintiff is not entitled to any relief requested in the Counterclaims because it comes to the Court with unclean hands.

RELIEF REQUESTED

WHEREFORE, Arduino prays for the following relief:

- A. Dismissal of the Counterclaims with prejudice;
- B. An award to Arduino of its costs and reasonable attorneys' fees; and
- C. Such other and further relief as the Court may deem just and proper.

JURY DEMAND

Arduino hereby demands a trial by jury on the Counterclaims and defenses so triable.

Dated: October 2, 2015

Respectfully submitted,

/s/ John L. Welch

John L. Welch BBO#522040
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Ave.
Boston, Massachusetts 02210
Telephone: (617) 646-8000
Email: jwelch@wolfgreenfield.com

Martin B. Schwimmer (*pro hac vice*)
Victoria Polidoro (*pro hac vice*)
Lori L. Cooper (*pro hac vice*)
LEASON ELLIS LLP
One Barker Avenue, Fifth Floor
White Plains, New York 10601
Telephone: (914) 288-0022
Email: Schwimmer@LeasonEllis.com
Email: Polidoro@LeasonEllis.com
Email: Cooper@LeasonEllis.com

Attorneys for Plaintiff

CERTIFICATE OF SERVICE

I certify that this document filed through the ECF system will be sent electronically to the registered participants as identified on the Notice of Electronic Filing (NEF) and paper copies will be sent to those indicated as non-registered participants on this 2nd day of October, 2015.

/s/ John L. Welch
John L. Welch